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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 124387-1	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to "Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] PAID TO: 571 273-8500 on <u>5/22/06</u></p> <p>Signature <u>Jean K. Testa</u></p> <p>Typed or printed name <u>MARY M. MCNAUL AREA</u></p>		Application Number 10/617,543 Filed 7/10/2003	
		First Named Inventor HARVEY Ellis Cline	
		Art Unit 3737	Examiner J. F. Ramirez
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39396</u>. <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p><u>Jean K. Testa</u> Signature <u>Jean K. Testa</u> Typed or printed name <u>518 387-5115</u> Telephone number <u>5/22/2006</u> Data</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> Total of _____ forms are submitted.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Group Art Unit: 3737
Harvey Ellis Cline, et al. : Examiner: John F. Ramirez
Serial No. 10/617,543 :
Filed: 07/10/2003
For: SYSTEM AND METHOD FOR THE DETECTION
OF BRAIN IRON USING MAGNETIC
RESONANCE IMAGING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Assistant Commissioner of Patents and Trademarks,
Washington, DC 20231

SIR:

In response to the Office Action dated February 24, 2006, in which Applicants' claims have been twice rejected, Applicants respectfully submit a Pre-Appeal Brief Request for Review. A Notice of Appeal in compliance with 37 C.F.R. 41.31 is submitted concurrently with this request.

It is respectfully requested that the following remarks be considered.

REMARKS/ARGUMENTS

In Office Actions mailed Oct. 4, 2005 and February 24, 2006 Applicants' claims 1, 3, 6, 7, 9, 10, 11 and 13 were rejected under 35 USC §103 (a) as being unpatentable over Bartzokis et al. (US 5,322,682) in view of Jesmanowicz et al. (US 5,603,322); and claims 4, 5, 14 and 15 were rejected under USC §103 (a) as being unpatentable over Bartzokis et al. (US 5,322,682) in view of Jesmanowicz et al. (US 5,603,322) and in further view of Jesmanowicz et al. (US 6,294,972). In the amendment responding to the Oct. 4, 2005 office action, claims 1 and 9 were amended to more clearly recite the invention and now each recite acquiring magnetic resonance images "at the substantially high magnetic field strength".

Improper Prima Facie Case of Obviousness – No Motivation to Combine

Applicants respectfully traversed the rejection of claims 1, 3, 6, 7, 9, 10, 11 and 13 under

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35 USC 103(a) over Bartzokis et al. in view of Jesmanowicz et al. ('322 patent) and further respectfully traversed the rejection of claims 4, 5, 14 and 15 further in view of Jesmanowicz et al. ('972 patent) asserting that the Examiner failed to establish a *prima facie* case of obviousness, there must be some teaching, suggestion or motivation to combine or modify the applied references. Applicants' interpreted the Oct. 4, 2005 Office Action as stating the proposed modification or combination is the method of measuring iron from Bartzokis with the pulse sequences of the Jesmanowicz references. However, Applicants' respectfully submitted that the proposed combination is not suggested or taught by the applied references and therefore a *prima facie* case of obviousness had not been established.

For example, Applicants' independent claims 1 and 9 each recite acquiring magnetic resonance (MR) images at the substantially high magnetic field strength to create a magnetic field map and characterizing regions of interest using the field maps. Neither of the applied references, either alone or in combination, teach or disclose acquiring MR images at a high magnetic field strength and *further do not teach acquiring said images to create a magnetic field map for use in characterizing regions of interest* (emphasis added in italics) as particularly recited in claims 1 and 9. In response to the Oct. 4, 2005 office action, Applicants argued that by contrast, the Bartzokis reference teaches taking MR images at two different field strengths and does not teach that a single high field strength could be employed. The two Jesmanowicz references do not overcome the deficiencies of Bartzokis – both references merely disclose methods for imaging the brain, however there is no teaching of the particular problem of imaging brain iron stores. A combination of the Bartzokis reference and either or both of the Jesmanowicz references would not obtain Applicants' recited invention. Further, the Bartzokis reference teaches away from Applicants' recited invention in that Bartzokis teaches a method requiring different field strengths (and therefore multiple imaging sessions) to obtain iron information. As such, Applicants respectfully submit that no reasonable combination of the Bartzokis and Jesmanowicz references would obtain Applicants' recited invention. Therefore, Applicants respectfully submit that independent claims 1 and 9, and claims depending thereon, are patentable over the Bartzokis and Jesmanowicz references.

Improper Prima Facie Case of Obviousness – All Claim Limitations not Considered

However, in the Feb. 24, 2006 office action the Examiner maintained the rejection under 35 USC 103 over both references without identifying where either reference teaches Applicants' recited "*acquiring said images to create a magnetic field map for use in characterizing regions of interest*". Applicants wish to respectfully point out that the Examiner has failed to provide a *prima facie* rejection in that he/she did not consider all of Applicants' recited elements when making the proposed combination.

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Specifically, the Examiner did not consider the recited claim element of the creating a magnetic field map for use in characterizing regions of interest. As such, there was no explanation in making the proposed combination of the Bartzokis and Jesmanowicz's references that would substantiate the rejections made under 35 USC 103.

Therefore, Applicants' respectfully submit that claims 1-15 are allowable and requests a reconsideration of Applicants' arguments in response to the rejections under 35 USC §103 (a).

In view of the remarks set out above, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are respectfully requested.

Should the Panel Members believe that anything further is needed to place the application in condition for allowance, the Examiner or Panel Members are requested to contact Applicants' undersigned representative at the telephone number below.

Respectfully submitted,



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May 22, 2006

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